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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/531,978	03/20/2000	Edward I. Sun	AVERP2720US	6960

7590 10/15/2004  
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Cleveland, OH 44115

EXAMINER
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ZIRKER, DANIEL R

ART UNIT	PAPER NUMBER
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1771

DATE MAILED: 10/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE -3- MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- ☒ Responsive to communication(s) filed on 7/29/04 and 8/17/04
- ☒ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

### Disposition of Claims

- ☒ Claim(s) 56 - 87 is/are pending in the application.
- Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 56 - 87 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement

### Application Papers

- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).
- ☐ All ☐ Some\* ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

\*Certified copies not received: \_\_\_\_\_

### Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 56-59, 61-81, and 83-87 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Japanese Patent Kokai 59/49971 Translation, substantially for the reasons set forth in paragraph No. 5 of Paper No. 070104, together with the following additional observations. Applicants argue vigorously (Response, page 8, last complete paragraph) that "there is no basis for the examiner to conclude that the multilayer film of JP -971 inherently possesses the properties of the films of the presently claimed invention". The Examiner, however must respectfully disagree, noting in essence that the multilayer films of the claimed invention are made from the same materials such as applicants utilize and are processed in the same manner, e.g., biaxially oriented. Furthermore, applicants' conclusion that the "Young's modulus parameters are totally different from the modulus parameters specified in the main claims" has simply not been proven, particularly in the absence of a suitable comparative declaration which examines more than one specific embodiment such as was set forth in the previously cited reference, Appendix 5 "films TS&B Lab Report" of September 16, 1997, in which one specific embodiment, the Example in JP '971, was tested.

However, applicants' claims are much broader than this one specific embodiment, and thus in the absence of a suitable comparative declaration the Examiner can only note that applicants' attorney's arguments without more are simply inadequate and fail to rebut the prima facie case of record. In a similar vein, with respect to applicants' remarks (Response, pages 9-10 bridging paragraph) that "there is no teaching or suggestion contained on these pages that would even suggest that the properties of the film specified in the present claims are inherently contained in the films described on pages 3-5" the Examiner can again only note that the films disclosed therein are formed from the same materials that applicants utilize, followed by a suitable stretching in both directions. Accordingly, even if the specific values contained for the "machine direction" are greater or less than that contained in the "cross direction", modifying the Young's Modulus parameter by, e.g. slightly changing the composition is strongly believed to be a property well within the ordinary skill of the art. In a similar vein, applicants' remarks (Response, page 10, second complete paragraph) that there are differences in the stretch orientations of the machine versus cross direction "by at least 10%" and that claim 65 specifies "at least 20%" is again believed to be a mere optimization of properties for one of ordinary skill, depending

upon the intended end use of the product. Finally, applicants' remarks (Response, page 10, third complete paragraph) that JP -971 at times teaches away from the particular tensile modulus claimed is simply not believed to be accurate; the tensile modulus is a parameter which can be modified by a suitable choice of ingredients in the formation thereof and the reference shows no particular predisposition to obtain any specific certain range beyond the broad ranges cited which overlap with the claimed invention.

3. Claims 60 and 82 are rejected under 35 U.S.C. § 103(a) as being unpatentable over JP -971, substantially for the reasons set forth in paragraph No. 6 of Paper No. 070104, together with the following additional observations. With respect to applicants' remarks (Response, page 11, first complete paragraph) wherein applicants argue that "the reference teaches that the filler content presumably can be 0" and this conclusion by the Examiner is without foundation, the Examiner again notes the teaching at page 4, top paragraph of the reference wherein it is stated that "the fillers are contained in an amount of 10 weight percent-40 weight percent, preferably 15 weight percent-35 weight percent. If the content of the fillers is less than 10 weight percent, white and opaque films cannot be obtained".

Accordingly, the Examiner states that this section of the

reference clearly supports his statement that the reference discusses films where the filler weight percent is as low as 0 wt.%. Finally, with respect to claim 82 (Response, pages 11-12 bridging paragraph) the Examiner notes that applicants there argue a product-by-process limitation, i.e. that films prepared "by simultaneous biaxial orientation" rely on a product-by-process limitation not shown on the record to produce a patentably distinct article.

4. **THIS ACTION IS MADE FINAL.** Applicants are reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE

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STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is (571) 272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 A.M. to 6:00 P.M. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on (571) 272-1478. The fax phone number for this Group is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either private PAIR or public PAIR. Status information for unpublished applications is available through private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Dzirker:cdc

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October 13, 2004

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP ~~1500~~  
1700

*Daniel Zinker*